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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,022	12/23/1998	ROLF LASSON	TP1192-US	6097

7590

06/18/2002

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/18/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=20

Office Action Summary

Application No.

09/214,022

Applicant(s)

LASSON, ROLF

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-17 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-17 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

REJECTIONS REPEATED

1. The 35 U.S.C. §112, 1st paragraph rejection claims 27-30 is repeated for reasons previously of record in paper #18, page 3, paragraph #8.
2. The 35 U.S.C. §103 rejections are repeated for reasons previously of record in paper #18, pages 3-6, paragraphs #9-11.

ANSWERS TO APPLICANT'S ARGUMENTS

3. Applicant's arguments filed in paper #19 regarding the 35 U.S.C. §112, 1st paragraph rejection of record have been carefully considered but are deemed unpersuasive.

Applicant disagrees with the Examiner's rejection of claims 27-30 under 35 U.S.C. §112, 1st paragraph and directs the Examiner to the specification page 5, lines 16-21 and page 6, lines 19-25 to give support for the addition of the negative limitation "non-scored crease lines".

The first passage to which Applicant refers the Examiner does not disclose the process that imparts the crease/fold line. This passage merely points out the novelty of the invention at the crease line is a reduced or eliminated adhesion between the core layer (11) and layer (12). The second passage Applicant points out discusses using both conventional mechanical deforming, which Applicant argues is equivalent to scored crease lines, and adhesion-reaction between the layers at the fold region. This passage in fact promotes using scored crease lines and advocates that Applicant's novel feature achieves better defined folds and corners when scored crease lines are used in combination.

The fact is that neither passage Applicant has pointed out, nor anything else in the specification gives support for the not using scored crease lines. The specification does not teach that the use of scored crease lines will destroy the invention, nor does it have any working examples to show that scored crease lines were not used. The specification in fact teaches that using scored crease line helps the invention achieve better defined fold and corners.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

4. Applicant's arguments filed in paper #19 regarding the 35 U.S.C. §103 rejection over Zinn (2,558,918) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Zinn fails to disclose the first and second layers are coextensive and without questions fails to disclose the entirety of the claimed invention. The Examiner does not dispute this point and has pointed out in the previous office action that Zinn fails to disclose that the cardboard blank and liner are coextensive with one another. However the Examiner has offered motivation to make the modification; "it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the layers coextensive. One of ordinary skill would be motivated to do so because it would make manufacturing the cartoon faster and insure the entire cartoon would be liner." Applicant has failed to provide reasons for why this motivation to modify the invention is not obvious. There is no requirement that a motivation to make the modification be expressly articulated. The reference is evaluated by what they suggest to one versed in the art, rather than by its specific disclosure.

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5. Applicant's arguments filed in paper #19 regarding the 35 U.S.C. §103 rejection over Zinn (2,558,918) in view of Skjelby (4,206,867) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that there is simply nothing that the Examiner has set forth that would suggest to one skilled in the art to make the claimed combination. More specifically that the Examiner has failed to show the teaching, motivation or suggestion, to make the combination.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 197). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, the has offered motivation to make the modification; "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to add the abhesive material of Skjelby to the crease lines of Zinn because it would help the liner more easily separate from the cardboard blank at the corners." Applicant has failed to provide reasons for why this motivation to modify the invention is not obvious or why specifically the references can not be combined.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Applicant further argues that Examiner's rejection to "process limitations" is wrong because these limitations are not process limitations but functional limitations. The Examiner is confused about which limitations Applicant is referring. The limitations in which the Examiner was referring are "the non-scored crease line and first and second layers are darkened," as stated in the previous office action. These limitations were deemed process limitations because "non-scored" refers to the process in which the crease lines were imparted into the layers and the layers being darkened refers to the process of heating and curing the adhesive between the two layers. The Examiner is unclear about which limitations Applicant is referring to as merely functional limitations.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

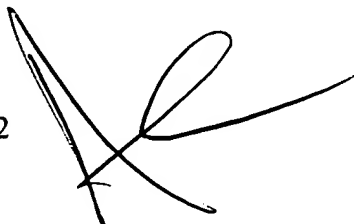
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

6/12/02




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

6/14/02